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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,409	09/17/2001	Jean-Louis Gueret	204296USOPCT	6084

22850 7590 04/17/2003

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
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EXAMINER

DOAN, ROBYN KIEU

ART UNIT PAPER NUMBER

3732

DATE MAILED: 04/17/2003

#7

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED: 4/22/03  
OBLON, SPIVAK, MCCLELLAND  
MAIER & NEUSTADT, P.C.  
DOCKETING DEPT.  
Initials/Date Docketed: PP 4/22/03  
Type of Resp(s): RD  
Due Date(s): 7-17-03

# Office Action Summary

Application No.

09/787,409

Examiner

Robyn Doan

Applicant(s)

GUERET, JEAN-LOUIS

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 17 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 24-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 24-29, 33-35, 37, 39-42 and 44-46 is/are rejected.
- 7) ☐ Claim(s) 30-32, 36, 38 and 43 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

Claims 40 and 44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 44 recites the limitation "said absorbent material" in line 19. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 40, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 24, 34 and 45-46 are rejected under 35 U.S.C. 102(b) as being anticipated by Hirzel.

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With regard to claims 24, 34 and 45-46, Hirzel discloses a cosmetic device for applying a product to eyelashes or eyebrows (figs. 3 and 7) comprising a container (20) containing a reserve product and an applicator member (12a, fig. 7) capable of being arranged removably on the container, the applicator having a comb which comprises an arrangement of teeth (54, 76a) being obtained by assembling at least two separate parts (52a, 53a); the comb is also securing to an element for grasping (19, fig. 3).

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 24, 27-29 and 33-35 are rejected under 35 U.S.C. 102(b) as being anticipated by French Patent '805 (Applicant's cited reference).

With regard to claims 24, 27-29 and 33-35, French Patent '805 discloses a cosmetic comb for applying a product for eyelashes or eyebrows comprising an arrangement of teeth (3, 4) being obtained by assembling at least two separate parts (1, 2), the parts being obtained by molding separate thermoplastic parts which are assembled by snap-fastening means (14, 15, 16, 17) consisting of at least one male/female system; at least one of the part comprising a succession of teeth (3) configuring in the form of at least one row connected to a base (5) of elongate shape extending along an axis and wherein the teeth being offset in a staggered configured alternating from side to side of a surface formed; the comb is also secured to an element (7) for grasping.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application

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by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 24, 39 and 45-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Dumler.

With regard to claims 24, 39 and 45-46, Dumler discloses a cosmetic device for applying a product to eyelashes or eyebrows (figs. 1-2) comprising a container (8) containing a reserve product and an applicator member capable of being arranged removably on the container, the applicator having a comb which comprises an arrangement of teeth (5, 3) being obtained by assembling at least two separate parts (2 and 5); the device further comprising a means (7) capable of consolidating the assembly of the two parts.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24-26, 28-29, 37 and 45-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery et al in view of abstract of Japanese patent "033 (Applicant's cited reference).

With regard to claims 24-26, 28-29, 37 and 45-46, Montgomery et al discloses a cosmetic container (fig. 3) for applying eyelashes comprising a container (13) containing a reserve of product (47) and an applicator (11) capable of being arranged removably on the container, the applicator having an element (31) for grasping equipped with a comb (35) with an arrangement of teeth (37). Montgomery et al does not disclose the arrangement of teeth being obtained by assembling at least two separate parts, however, Japanese Patent abstract '033 discloses a comb having an arrangement of teeth (2) being obtained by assembling at least two separate parts (1a, b), the parts being obtained by molding thermoplastic in a single piece and being joined together pivotably by a film hinge (3) which is oriented parallel to the axis; at least one of the part comprising a succession of teeth (2) configuring in the form of at least one row connected to a base (1a) of elongate shape extending along an axis and wherein the teeth being offset in a staggered configured alternating from side to side of a surface formed (abstract figure). It would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ the particular comb as discussed above as taught by JP Patent '033 into the cosmetic device of Montgomery et al for the intended use purpose.

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Claims 40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirzel.

With regard to claims 41-42, Hirzel discloses a cosmetic device comprising all the claimed limitations in claim 24 as discussed above except for the thermoplastic material containing agents graphite, disulside; the parts being made of different materials and at least one portion of at least one of the parts being covered in flocking. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the thermoplastic material containing agents graphite, disulside; the parts being made of different materials and at least one portion of at least one of the parts being covered in flocking, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

Claims 30-32, 36, 38 and 43 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wagner and Leone are cited to show the state of the art with respect to a cosmetic device having two separate parts of brush.

The drawings filed 09/17/2001 have been approved by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robyn Doan whose telephone number is (703) 306-9182. The examiner can normally be reached on Mon-Fri 9:30-7:00; alternate Mondays off.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Robyn Kieu Doan  
Examiner  
April 10, 2003

John J. Wilson  
Primary Examiner